

Appl. No. 10/530,096
Amdt. Dated August 30, 2006
Reply to Office Action of June 1, 2006

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•••REMARKS•••

The Office Action of June 1, 2006 has been thoroughly studied. Accordingly the changes presented herein for the application, considered together with the following remarks, are believed to place the application into condition for allowance.

By the present amendment, applicants are submitting a copy of the original specification, formatted so that the page numbers are also copied on the bottom of each page.

This copy of the specification corrects the previous copy in which the page numbers were inadvertently deleted due to copying from A4 paper to standard 8.5 x 11 inch paper.

Also the specification has been changed at page 42 to add text from the original Japanese application to which priority is claimed, which text is fully supported by the reference to injection molding found throughout the specification and the reference to moldings having "a lighter weight and a smaller thickness" made in reference to fuel cell gaskets (see for example the paragraph bridging pages 2 and 3 of the original specification.

Claims 2, 7, 10 and 15 have been rewritten in independent form.

Claims 1, 11-14, 20-31 and 33 have been cancelled.

Each of claims 2, 7 and 15 have further been changed to recite the combination of a sealing material with an automobile cam cover, an automobile engine oil pan and an automobile wire harness, respectively.

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Entry of the changes to the specification and claims is respectfully requested.

Claims 2-10, 15-19, and 32 remain pending in this application.

Claims 1-5, 7-9, 11-18 and 25-31 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-10 of copending application serial No. 10/506,488.

Claims 1-9, 11-17, 25-31 and 33 stand rejected under 35 U.S.C. §102(b) as being anticipated by Japanese reference No. 2000-154255 to Fujita et al.

Claims 18 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fujita et al.

Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,731,069 to Delle Donne et al. in view of Fujita et al.

Claims 20-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0028527 to Bae et al. in view of Fujita et al.

For the reasons set forth below, it is submitted that all of the pending claims are allowable over the prior art of record and therefore, each of the outstanding prior art rejections should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

The rejection of claims 20-24 is moot inasmuch as these claims have been canceled.

The pending claims 1-10 of copending application serial No. 10/506,488 are reproduced herein as follows:

Claim 1. A material for vibration-absorbable mounts that has a loss tangent

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(tan δ) of at least 0.5, which comprises a cured product of a composition comprising (A) an acrylic polymer having at least one alkenyl group capable of undergoing hydrosilylation reaction, (B) a hydrosilyl group-containing compound and (C) a hydrosilylation catalyst as essential components.

Claim 2. A material for vibration-absorbable mounts according to Claim 1, wherein a liquid acrylic polymer having a number average molecular weight M_n of 500 or more and a molecular weight distribution (M_w/M_n) of 1.8 or less is used as component (A) of the composition.

Claim 3. A material for vibration-absorbable mounts according to Claim 1, wherein the cured product of the composition has a Duro A hardness of 45 or less.

Claim 4. A material for vibration-absorbable mounts according to Claim 1, wherein 100 parts by weight or less of a reinforcing agent or filler is added to the composition on the basis of 100 parts by weight of the sum total of components (A), (B) and (C).

Claim 6. A material for vibration-absorbable mounts according to Claim 1, which comprises an article that is in a contact with electronic components or electronic assemblies.

Claim 7. A material for vibration-absorbable mounts according to Claim 1 comprising a vibration-absorbable mount for a hard disc drive.

Claim 8. A material for vibration-absorbable mounts according to Claim 7, wherein the material for vibration-absorbable mounts is fixed to a cover of a box housing the hard disc drive.

Claim 9. A material for vibration-absorbable mounts according to Claim 7, comprising a vibration-absorbable mount for a hard disc drive that is mounted in an automobile.

Claim 10. A material for vibration-absorbable mounts according to Claim 3, wherein 100 parts by weight or less of a reinforcing agent or filler is added to the composition on the basis of 100 parts by weight of the sum total of components (A), (B) and (C).

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The Examiner will note that these claims are directed to a material for vibration-absorbable mounts.

In contrast, the claims of the present application are directed to various sealing applications which require and rely upon properties of the materials which are not obvious over the claims 1-10 of copending application serial No. 10/506,488 - which are limited to vibration-absorbing mount applications.

For example, in the case of sealing materials for cam covers and oil pans, it is important to provide a sealing material that can limit the fastening/sealing pressure. Otherwise, cam covers and oil pans can tend to become deformed when excessive pressures are required to seal these articles due to their relative thinness and particularly as they are lately fabricated from resinous materials.

Vibration-absorbing materials have no nexus or obvious application to such sealing materials.

A similar or perhaps stronger argument applies to wire harness seals. That is, there is no relationship between wire harness seals and vibration adsorbing mounts.

Accordingly, the vibration-absorbing materials of copending application serial No. 10/506,488 do not render pending claims 2-5, and 15-18 obvious as required under 35 U.S.C. §103.

In applying the teachings of Fujita et al. to claims 1-9, 11-17, 25-31 and 33 the Examiner states:

Note the intended uses of the material set forth in the instant claims do not carry any weight of patentability.

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It is noted that the Examiner has not rejected claim 10 or claim 19 over Fujita et al. since these claims specifically recite an automobile engine oil pan and an automobile wire harness.

It is noted that claims 2, 7 and 15 have been changed to recite the combination of a sealing material with an automobile cam cover (claim 2), an automobile engine oil pan (claim 7) and an automobile wire harness (15).

Accordingly, Fujita et al. is no longer applicable as anticipating the limitations of these claims, inasmuch as they do not merely claim the sealing material.

That is, as the Examiner has concluded. Fujita et al. does not teach a seal in combination with automobile cam cover or in combination with an automobile wire harness - or in combination with an automobile engine oil pan.

Moreover, Fujita et al. is no longer applicable to claims 18 and 32 which depend from claim 15.

The Examiner has relied upon Delle Donne et al. as disclosing:

...an automobile wire harness sealed by an acrylic-containing sealing material where vibration suppression is desirable. (col. 2, lines 40-56 and col. 4, line 6 to col. 5, line 8).

In combining the teachings of Delle Donne et al. and Fujita et al. the Examiner takes the position that:

....it would have been obvious...to utilize JP255's sealing material for Delle's wire harness seal materials with expected success.

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The only mention of "wire harnesses" in Delle Donne et al. is at Column 2, lines 39-56 where it is disclosed:

Depending on the size and shape of gage and drain holes, the nature of the surface defining the hole, and the cover employed, various problems are presented by existing systems that are not presented by the present invention. For example corrosion, which can be initiated in existing systems that employ metal caps, is resisted with the present system. Added weight due to the present sealing system is about 50% less than with metal cap systems. Vibration suppression is believed to be better due to the nature of the materials used. Excellent tear resistance and flexibility of the gage and drain hole sealer of the present invention reduce the risk of cap dislodgment upon sudden impact as in an accident and resultant secondary damage to other automobile components such as gasoline tanks and wire harnesses. The sealer of the present invention is a unitary structure that can be more easily stored and applied than other sealing

As noted this reference to "wire harnesses" has to do with the tear resistance and flexibility of gage and drain hole sealers which properties reduce secondary damage (in the event a cap should dislodge upon sudden impact) to other automobile components such as gasoline tanks and wire harnesses.

It is only the "secondary damage to "other...components such as...wire harnesses" that is of concern.

There is no mention of using the "composite gage and drain hole sealer" (per title) in conjunction with wire harnesses.

Delle Donne et al. expressly teaches that:

The present invention relates to a composite patch which is useful for effectively and durably sealing and plugging holes in workpieces.

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It is therefore submitted that Delle Donne et al. does not teach "sealing" wire harnesses.

Accordingly, the Examiner's reliance and interpretation of Delle Donne et al. is in error and the rejection of the claims based upon the Examiner's combination of Delle Donne et al. and Fujita et al. is unfounded and should properly be withdrawn.

The Examiner has relied upon Bae et al. as disclosing:

...an HDD containing a cover gasket for restraining noises and vibration generated in a base from transferring to the cover.

In combining the teachings of Bae et al. and Fujita et al. the Examiner has taken the position that:

... it would have been obvious...to utilize JP255's sealing material for Bae's gasket materials with expected success.

Bae et al. is directed to a "noise and vibration dampening device" that comprises structure to reduce the speed or air flow in a HDD.

Whereas Bae et al. does disclosed the use of a conventional gasket 126, Bae et al. provides no requirements for or details of the gasket 126.

On page 35 of applicants' specification, applicants have summarized comparative test results which lean to the conclusion that:

It is evident from the foregoing that the vulcanization molding products obtained from the compositions of Examples 6-9 have a low hardness, good heat resistance and oil resistance, a good tight adhesiveness to the electric wires and a low out gassing property, and can be used as suitable wire harnesses sealing materials for automobiles, whereas that of Comparative Example 7 has a high hardness and a poor

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tight adhesiveness to the electric wire, that of Comparative Example 8 using acrylic rubber has low practical strengths and a poor compression set characteristic and furthermore a poor tight adhesiveness to the electric wire, and that of Comparative Example 9 using silicone rubber has a good heat resistance, but a poor oil resistance and furthermore a poor tight adhesiveness to the electric wire.

It is submitted that the sealing materials of applicants' invention have improved properties as demonstrated by applicants' comparative tests, and provide seal members that can limit the fastening/sealing pressure as discussed above.

Fujita et al. does not teach any particular advantage of the curable compositions which would provide any benefit, if at all suitable, for use in Bae et al.

Moreover, Bae et al. is completely silent as regards the material from which gasket seal 126 is made.

It thus follows that there is no motivation (outside of applicants' own disclosure) to combine the teachings of Bae et al. and Fujita et al. as the Examiner suggests.

As held by the federal circuit in *In re Laskowski*:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. The prior art does not suggest applicants modification of the prior art, or provide any reason or motivation to make that modification. *In re Laskowski*, 10 USPQ 2d 1397 (Fed. Cir. 1989)

In the present situation, there is no suggest or motivation to support the Examiner's proposed combination.

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Further, applicants' have established improved properties of the claimed sealing materials which the prior art does to teach or suggest, including the limited fastening/sealing pressure noted above, the ability to be easily replaced (because of the low sealing pressure requirement), excellent sealability under heat and oil environments, tight adhesiveness to electric wires and good cleanliness (or low out gassing properties).

These properties further distinguish applicants' claimed sealing materials and rebut the Examiner's basis of obviousness over the prior art.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §102 as anticipating applicants' claimed invention.

Moreover, the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a prima facie case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejections of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejections of the claims and an early allowance of the claims is believed to be in order.

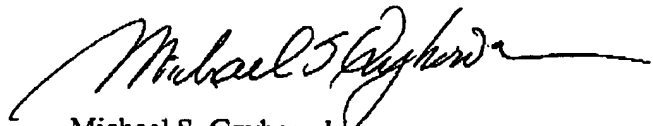
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It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



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